

O/0705/24

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION  
NO. 3955632  
BY TIANJIN TAIDU TECHNOLOGY DEVELOPMENT CO.,LTD.  
TO REGISTER THE TRADE MARK:

**A-LEGEND**

IN CLASS 11

AND

OPPOSITION THERETO  
UNDER NO. 446142  
BY  
LEGEND BRANDS, INC.

## Background

1. On 12 September 2023, Tianjin Taidu Technology Development Co.,LTD. (“**the applicant**”) applied to register trade mark number shown on the cover page of this decision in the UK. The application was published for opposition purposes on 1 December 2023. The applicant seeks registration for the following goods:

**Class 11:** Fans [air-conditioning]; Heating apparatus, electric; Thermostatic valves [parts of heating installations]; Radiators [heating]; Underfloor heating apparatus and installations; Shower cubicles; Sanitary apparatus and installations; Toilets [water-closets]; Radiators, electric; Lamps.

2. On 1 March 2024, Legend Brands, Inc. (“**the opponent**”) filed an opposition based on Sections 5(2)(a) and (b) of the Trade Marks Act 1994 (“**the Act**”)<sup>1</sup> and is directed against all of the goods in the application. The opponent relies upon the following mark:

<b>Trade Mark No.</b>	UK00908196917 <sup>2</sup>
<b>Trade Mark</b>	LEGEND BRANDS
<b>Goods&amp; Services for which the mark is registered</b>	Classes 2, 5, 7, 9, 11, 12, and 41
<b>Filing date</b>	2 April 2009
<b>Date of entry in register</b>	11 December 2009

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<sup>1</sup> The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

<sup>2</sup> On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM. As a result, the opponent’s earlier EUTM was automatically converted into a comparable UK trade mark. Comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

3. On 15 March 2024, the Registry served the TM7 on the applicant. The deadline for the applicant to file its Notice of defence and counterstatement ('Form TM8') was set at 15 May 2024 which was communicated by the Registry in the serving letter. The pertinent paragraphs of the letter are as follows:

"[...] Rule 18(1) and 18(3) of the Trade Marks Rules 2008 require that you must file your notice of defence and counterstatement (Form TM8) within **two months** from the date of this letter. Alternatively, if both parties wish to negotiate to resolve the dispute, they may request a "cooling off period" by filing a Form TM9c, which will extend the 2 month period in which to file a Form TM8 by up to a further seven months. Form TM9c is also available on the IPO website (above). Please note both parties must agree to enter into cooling off.

**IMPORTANT DEADLINE: A completed Form TM8 (or Form TM9c) MUST be received on or before 15 May 2024.**

Rule 18(2) of the Trade Marks Rules 2008 states that "*where an applicant fails to file a Form TM8 within the relevant period, the application for registration, insofar as it relates to the goods and services in respect of which the opposition is directed, shall, unless the registrar otherwise directs, be treated as abandoned.*"

**It is important to understand that if the deadline date is missed, then in almost all circumstances, the application will be treated as abandoned.** [...]" (original emphasis)

4. The applicant's Form TM8 was not received by the deadline of 15 May 2024.
5. On 31 May 2024, the Registry wrote to the applicant stating:

"The official letter dated 15 March 2024 invited the applicant to file a TM8 and counterstatement on or before 15 May 2024.

As no TM8 and counterstatement has been filed within the time period set, Rule 18(2) applies. Rule 18(2) states that the application:

“.....shall, unless the registrar otherwise directs, be treated as abandoned.”

The registry is minded to deem the application as abandoned as no defence has been filed within the prescribed period.

If you disagree with the preliminary view, you **must** provide full written reasons and request a hearing on, or before, **14 June 2024**. This **must** be accompanied by a Witness Statement setting out the reasons as to why the TM8 and counterstatement are being filed outside of the prescribed period.

If no response is received the registry will proceed to deem the application abandoned.”

In addition, the Registry made a reference to the Form TM33 filed on 3 May 2024 recording the change in the representation of the applicant.

6. On 14 June 2024, the applicant requested a hearing and submitted the late TM8 form along with a witness statement dated 12 June 2024. The witness statement was signed by Mr Eugene Pienaar, the applicant’s representative in these proceedings, outlining the reasons for the delayed filing of Form TM8 by its original deadline as follows:

“[...]

## **2. Reason for Late Filing**

2.1. The delay in filing the TM8 and counterstatement was due to an inadvertent oversight. The intention of the applicant has always been to defend against both opposition proceedings - No. OP000446142 and No. OP000446116.

2.2. Due to a misunderstanding, the TM8 and counterstatement were only filed against opposition No. OP000446116, and it was erroneously believed that both oppositions had been covered.

### **3. Intention to Defend**

3.1. The applicant has a genuine intention to defend against both oppositions. The failure to file the TM8 and counterstatement within the prescribed period was not due to any lack of interest or intention to abandon the application.

3.2. The applicant respectfully requests the registrar to exercise discretion under Rule 18(2) to allow the late filing of the TM8 and counterstatement.[...]"

7. A hearing was scheduled for 15 July 2024 and the details were sent to the parties in an official letter from the Tribunal on 26 June 2024. Both parties confirmed they would be attending the hearing, and the applicant filed skeleton arguments on 11 July 2024.

### **Skeleton Arguments**

8. The applicant's skeleton arguments reiterated the information from the previously submitted witness statement as mentioned above, but in a more detailed manner. In particular, the applicant's skeleton arguments provided the following:

"[...]"

#### **3.1 Exceptional Circumstances**

3.1.1 The Applicant's failure to file the TM8 and Counterstatement by the original deadline was due to exceptional circumstances, namely a misunderstanding on the part of the Applicant. The Applicant is Chinese and English is not their primary language. Due to the language barrier the Applicant was under the impression that they had instructed both oppositions to be defended. You will appreciate that

the difference between the singular and plural in the word opposition/oppositions has a big impact in meaning that could easily be overlooked by a Chinese speaker. The Applicant always intended to defend both oppositions. You will appreciate that defending one opposition but not the other is entirely nonsensical.

3.1.2 The failure to file the TM8 was purely an inadvertent oversight caused by a misunderstanding on the part of the Applicant. They erroneously believed they has instructed for both oppositions to be defended. It was an honest oversight. [...]"

### **The Joint Hearing**

9. The hearing took place before me, via telephone conference, on Monday, 15 July 2024. Mr Eugene Pienaar represented the applicant, and Ms Stephanie Taylor of Bristows LLP represented the opponent.
10. At the hearing, I explained to both parties that the purpose of the hearing was to consider whether the late filed defence should be admitted into the proceedings. I also highlighted that the TM8 deadline is a non-extensible time limit, pursuant to the relevant case law and Trade Mark Rules 2008 ("the Rules"). However, my discretion to allow the Form TM8 to proceed to be examined is a narrow one which can only be exercised where there are compelling reasons or extenuating circumstances.
11. I further confirmed that I had received the skeleton arguments from the applicant, and that I had read all the documents relevant to the case before me.
12. I note that this was a fairly brief hearing, and since both parties attended the hearing, I will briefly reassume their arguments and submissions.
13. Mr Pienaar's submissions were foreshadowed in his skeleton arguments. Mr Pienaar started by emphasising the change of the representatives after the admission of the TM7 clarifying that he was only instructed to take over

the representation of the application in question on 3 May 2024. He explained that when he received the official letter from the Registry (deeming the application as abandoned), he immediately informed the instructing agent about this oversight. He also noted that, due to the multiple changes in agencies, the Chinese client mistakenly assumed that both oppositions (i.e. OP000446116 and OP000446142) were to be defended, contrary to Mr. Pienaar's instructions to defend only one (OP000446116). When he took over the matter, he was initially unaware of the opposition at hand. Mr Pienaar also stressed that this was an obvious oversight, as it would not make sense for the applicant to defend one application but not the other, indicating a misunderstanding or confusion on the applicant's part. He concluded by requesting the Registry to exercise its discretion in this matter; otherwise, the applicant would refile the application and begin the process anew.

14. Turning to Ms Taylor, she drew my attention to Rule 18(2) and that the representatives were appointed before the TM8 deadline, giving them ample time to review the file and submit a counterstatement. However, they failed to do so. Ms Taylor submitted that the applicant/client was fully aware of the two oppositions, and it was their responsibility to provide clear instructions to defend against one or both oppositions. She pointed out that there appears to be no compelling reason why the deadline should be extended stating that the Rules and deadlines exist for good reason. Ms Taylor continued by adding that it is unreasonable to expect strict compliance with deadlines from one party while granting more flexibility to the other. She also stressed that the TM8 was filed a month later, rather than immediately after receiving the official letter from the Registry. Finally, Ms Taylor concluded by stating that there are no extenuating circumstances or compelling reasons in the circumstances that shows that the Registrar should exercise any discretion and extend the deadline.
15. In response, Mr Pienaar explained that the Registry provided a deadline to the applicant to challenge the preliminary view of the Registry and file full reasons and request a hearing, and they met that deadline.

16. Before concluding the hearing, I asked the parties to make submissions as to the costs. Mr Pienaar stated that their client is based in China, and any costs award would not necessarily be able to be enforced against them. He also mentioned that the opponent did not have to file any skeleton arguments for the hearing, thus spending minimal time on the matter, including the duration and attendance of this hearing. On the other hand, Ms Taylor requested a costs award in favour of the opponent, explaining that the opponent had incurred costs by also attending this hearing.
17. At the hearing, I reserved my decision to give me an opportunity to properly reflect on the submissions put forward by the parties. In making my decision, I have reviewed all of the papers on file, the applicant's skeleton arguments, and both parties' submissions, which I take into account.

## **Decision**

18. The filing of a Form TM8 and counterstatement in opposition proceedings is governed by Rule 18 of the Rules, which provides as follows:

“(1) The applicant shall, within the relevant period, file a Form TM8, which shall include a counter-statement.

(2) Where the applicant fails to file a Form TM8 or counter-statement within the relevant period, the application for registration, insofar as it relates to the goods and services in respect of which the opposition is directed, shall, **unless the registrar otherwise directs**, be treated as abandoned.

(3) Unless either paragraph (4), (5) or (6) applies, the relevant period shall begin on the notification date and end two months after that date”. (Emphasis added)

19. The combined effect of Rules 77(1), 77(5) and Schedule 1 of the Rules means that the time limit in Rule 18, which sets the period in which the

defence must be filed, is non-extensible other than in the circumstances identified in rules 77(5)(a) and (b) which provide that:

“A time limit listed in Schedule 1 (whether it has already expired or not) may be extended under paragraph (1) if, and only if—

(a) the irregularity or prospective irregularity is attributable, wholly or in part, to a default, omission or other error by the registrar, the Office or the International Bureau; and

(b) it appears to the registrar that the irregularity should be rectified.”

20. It was not disputed that the late filing of the Applicant’s TM8 in this instance was not because of an irregularity, default, omission or other error on the part of, *inter alia*, the Registrar. Therefore, my consideration is restricted to the limb of the discretion contained in the words “unless the registrar otherwise directs” under Rule 18(2).
21. In approaching the exercise of discretion in these circumstances, I take into account the decisions of the Appointed Person in *Kickz AG v Wicked Vision Limited* (BL O-035-11) and *Mark James Holland v Mercury Wealth Management Limited* (BL O-050-12), i.e. I have to be satisfied that there are extenuating circumstances which justify the exercise of the discretion in the applicant’s favour.
22. In *Music Choice Ltd’s Trade Mark* [2005] RPC 18, the Court indicated that a consideration of the following factors (underlined below) is likely to be of assistance in reaching a conclusion as to whether or not discretion should be exercised in favour of a party in default. That is the approach I intend to adopt, referring to the parties’ submissions to the extent that I consider it necessary to do so.

The circumstances relating to the missing of the deadline including reasons why it was missed and the extent to which it was missed

23. The circumstances as to why the deadline was missed are summarised above. The stipulated deadline for the filing of the applicant's Form TM8 and counterstatement was 15 May 2024. However, the Form TM8 and counterstatement were filed by the applicant on 14 June 2024, together with a witness statement providing reasons for not filing its defence. Therefore, the deadline was missed by a full month.

The nature of the opponent's allegations in its statement of grounds

24. The opposition is brought under Sections 5(2)(a) and (b) of the Act. There is nothing to suggest that the opposition is without merit.

The consequences of treating the applicant as defending or not defending the opposition

25. If the applicant is permitted to defend the opposition, the proceedings will continue with the parties given an opportunity to file evidence, and the matters will be determined on their merits. However, if the applicant is not allowed to defend its application, it will be treated as abandoned, and the applicant's mark will lose its filing date of 12 September 2023. Nevertheless, it will remain open to the applicant to re-file its application, which may, in turn, be open to opposition.

Any prejudice caused to the opponent by the delay

26. The opponent has not identified any prejudice other than costs.

Any other relevant considerations such as the existence of related proceedings between the parties

27. There do not appear to be any other relevant considerations.

## Conclusions

28. In reaching my decision, I bear in mind that the deadline for filing a Form TM8 is a statutory one, with the applicant having been made fully aware of the consequences of failing to comply by way of correspondence from the Tribunal. I recognise that if the discretion is not exercised in the applicant's favour, the application will be treated as abandoned and the applicant will lose its filing date for its mark. I also recognise that it may well be that the applicant's refiled application may again be opposed by the opponent resulting in further opposition proceedings arising at some point in the future.
29. Considering the specific circumstances in this matter, the reason for missing the initial deadline for the filing of Form TM8 was due to a critical oversight, resulting in the failure to file the Form TM8 and counterstatement in time. I bear in mind that the applicant was fully represented throughout these proceedings and that by their own admissions, the applicant had instructed their representatives, Mr Eugene Pienaar, to defend their application in relation to another opposition proceedings, failing to do so for this current one. I note that this amounts to a human error occurred during this process, resulting in the deadline being missed.
30. In *Praesidiad NV v Tescon Sicherheitssysteme Schweiz GMBH* ("Tescon"), BL O/240/20, Mr Geoffrey Hobbs Q.C. as the appointed person stated at paragraph 32 that:

"I readily accept that human error is not necessarily inconsistent with the existence of extenuating circumstances or compelling reasons for permitting invalidity proceedings to be defended in the exercise of the discretion conferred by rule 41(6) [...] It is nonetheless clear that the test to be applied cannot be taken to permit or require all human errors to be treated as excusable for the purposes of rule 41(6). There must, in other words, be a fact specific evaluation for the purpose of

determining whether the particular error in question should or should not be treated as excusable in the circumstances of the case at hand.”

31. Although *Tescon* concerned an application for invalidity, the same assessment is relevant to the late filing of a Form TM8 and counterstatement in opposition proceedings. Moreover, while, ultimately, the decision not to admit the Form TM8 into proceedings was upheld in *Tescon*, Mr Hobbs acknowledged that human errors can constitute extenuating circumstances or compelling reasons sufficient for the exercise of discretion, where the specific facts of the case merit it.
32. Whilst I acknowledge human error can occur, I find this is hardly a compelling reason, especially as the applicant is professionally represented, and it does not appear that the client/instructing agent has exercised the “minimal degree of vigilance”<sup>3</sup> required to accurately instruct the representatives in these proceedings about the deadline to file a Form TM8 in order to defend the application. I also note that the applicant was well aware of the opposition process and the strict statutory two month deadline to file a Form TM8, as explicitly stated in the Tribunal’s letter, along with the consequences for not submitting the Form TM8 by this deadline.
33. Considering all the factors above, I do not find that the necessary reasons have been made out. The filing of a Form TM8 is a relatively simple task, capable of being successfully carried out, irrespective of whether an applicant is represented.
34. Accordingly, whilst I am sympathetic to the applicant’s position, taking all of the above into account, I find no single reason or combination of reasons sufficient to constitute extenuating circumstances or compelling reasons to enable me to exercise my (limited) discretion under rule 18(2), to admit the late filed Form TM8 and counterstatement into these proceedings.

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<sup>3</sup> See *Kickz AG v Wicked Vision Limited*, BL-O-035-11, in paragraph 15.

## **Outcome**

35. The late Form TM8 is not to be admitted into the proceedings. Consequently, as the opposition against the application at hand is deemed as undefended, the application will, subject to any appeal, be treated as abandoned.

## **Costs**

36. As my decision terminates the proceedings, I must consider the matter of costs. Awards of costs are set out in Tribunal Practice Notice (“TPN”) 1/2023. Using the guidance set out in the TPN, I award the opponent costs on the following basis:

Official opposition fee	<b>£100</b>
Preparing a notice of opposition	<b>£200</b>
Preparing for and attending the hearing	<b>£300</b>
<b>Total</b>	<b>£600</b>

37. I order Tianjin Taidu Technology Development Co.,LTD. to pay to Legend Brands, Inc. the sum of £600. This sum is to be paid within two months of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 26<sup>th</sup> day of July 2024**

**Dr Stylianos Alexandridis**

**For the Registrar,**

**The Comptroller General**